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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,845	12/29/2005	Hyung-Nam Choi	2003P09468WOUS	5844
22116	7590	04/22/2008	EXAMINER	
SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 170 WOOD AVENUE SOUTH ISELIN, NJ 08830			CHAMBERS, TANGELA T	
ART UNIT	PAPER NUMBER			
		4141		
MAIL DATE	DELIVERY MODE			
04/22/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,845	<b>Applicant(s)</b> CHOI ET AL.
	<b>Examiner</b> TANGELA T. CHAMBERS	<b>Art Unit</b> 4141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 29 December 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13-31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 December 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1668)  
 Paper No(s)/Mail Date December 29, 2005
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the preliminary amendment filed on 12/29/2005.
2. Claims 1-12 have been canceled.
3. Claims 13-31 have been added.
4. Claims 13-31 are pending.

#### ***Priority***

5. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in the instant Application No. 10562845, filed on December 29, 2005.

#### ***Information Disclosure Statement***

6. The IDS filed on December 29, 2005 has been acknowledged by the examiner.

#### ***Claim Objections***

7. **The claims are objected to because of the following informalities:**  
Claims 19, 20 and 28 are objected to because the word 'favorable' should be replaced with the following spelling – favorable –.  
Appropriate corrections are required.

#### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-31 are rejected under U.S.C. 101.

Claim 13 is rejected because the claimed invention is directed to non-statutory subject matter. Although claim 13 is a method claim, it is non-statutory because it does not produce a useful, concrete and tangible result, and is therefore not eligible for patent protection.

Claims 14-24 are dependant on claim 13, and are rejected under the same reason set forth in connection of the rejection of claim 13.

Claim 25 is rejected because the claimed invention is directed to non-statutory subject matter. Claim 25 uses a selector for choosing a service provider but is still considered non-statutory because a useful, concrete and tangible result is not produced, and is therefore not eligible for patent protection.

Claims 26-31 are dependant on claim 25, and are rejected under the same reason set forth in connection of the rejection of claim 25.

***Claim Rejections - 35 USC § 112 Second Paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 16, 25 and 30 are rejected under 35 U.S.C. 112, second paragraph.

Claim 13 is a method claim but is stated as being used within "a radio communication system". It is inappropriate to combine a method and a system claim. It is suggested that claim 13 be rewritten with the words "of a radio communication system" deleted.

Claim 16 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 16 states the service providers "can" indicate a value within a first time interval. It is suggested that claim 16 be rewritten with the word "can" deleted or changed to a definitive verb.

Claim 25 is a device claim but is stated as being used within "a radio communication system". It is inappropriate to combine a device and a system claim. It is suggested that claim 25 be rewritten with the words "of a radio communication system" deleted.

Claim 30 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 30 states that the selection parameter may include a price "and/or" the quality of service. The claim should be rewritten with the phrase changed to "or".

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13, 15-16, 22-25, 27 and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Engelhart (US Patent Publication No. 2004/0203580 A1).

As per claim 13, Engelhart discloses:

- *A method for selecting a provider that provides a service that can be received by a mobile station via a radio access network of a radio communication system and is provided by a plurality of service providers via the radio access network* (Engelhart, Abstract and Page 2, Paragraph [0023]).

- ***receiving from the mobile station via a radio interface of the radio access network a request to select a provider for the service from the plurality of service providers by a selecting device;*** (Engelhart, Fig. 2 and Page 2, Paragraphs [0023]-[0024]), Engelhart teaches a mobile device requesting services (capabilities) from a plurality of providers via a selecting device (access node).
- ***requesting the plurality of service providers to indicate a value of a selection parameter by the selecting device;*** (Engelhart, Fig. 2 and Page 2, Paragraph [0024], "The access node 102, in turn, communicates to call control nodes 106,108 the queries Q2 and Q3, respectively, for capabilities and costs. The call control node 106 communicates queries Q4 and Q5 to the service nodes 112,114, respectively, for capabilities and costs.").
- ***selecting the provider by the selecting device based on the values received from the indication request.*** (Engelhart, Fig. 5 and Page 3, Paragraph [0033], "With reference to FIG. 5, the device 122 displays the information of response R5 as a list of options 502. The options reflect the capabilities and cost information returned in response to the queries." ... "The device 122 may be configured to automatically select a combination of access, quality, and service based upon the device user's preferences and the costs. Alternatively, the user of the device 122 can select a combination of access, quality, and service from the list.").

As per claim 15, the rejection of claim 13 is incorporated and further Engelhart discloses:

- ***the selecting device assigns the mobile station to the selected provider for a connection setup via the radio interface.*** (Engelhart, Page 3, Paragraph [0036]).

As per claim 16, the rejection of claim 13 is incorporated and further Engelhart discloses:

- ***the plurality of service providers can indicate the value within a first time interval, or wherein after a second time interval the provider is selected.***  
(Engelhart, Page 3, Paragraph [0033], "Further, a user device may periodically request

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updated costs and services information from the network, without requiring subscriber initiation. Rules may be set-up by a subscriber to request or select specific services according to a rule set."), Engelhart teaches that user defined parameters may be set up in order to periodically receive updated information regarding service providers, and selecting a provider based on the new information. It is inherent that the user could define how often the information should be updated and when selection should occur.

As per claim 22, the rejection of claim 13 is incorporated and further Engelhart discloses:

- ***the selection parameter is defined by the mobile station.*** (Engelhart, Abstract and Page 3, Paragraph [0033], "The device 122 may be configured to automatically select a combination of access, quality, and service based upon the device user's preferences and the costs."), Engelhart teaches the selection parameter based on the

As per claims 23 and 24, the rejection of claim 13 is incorporated and further Engelhart discloses:

- ***the selection parameter includes a price of the service and quality of service.*** (Engelhart, Fig. 5 and Page 3, Paragraph [0033], "The options reflect the capabilities and cost information returned in response to the queries. The options include the type of access available (for example, GPRS or DSL), the quality of service (bits per second, voice only, voice and data), and services available (voice mail, stock quotes, email, web browsing, video), and the cost per minute.").

As per claim 25, Engelhart discloses:

- ***A selecting device for selecting a provider for a service that can be received by a mobile station via a radio access network of a radio Communication system and is provided by a plurality of service providers via the radio access network*** (Engelhart, Abstract and Page 3, Paragraph [0033], "The device 122 may be configured to automatically select a combination of access, quality, and service based upon the device user's preferences and the costs.").

- ***a receiver capable of receiving a request sent by the mobile station via a radio interface of the radio access network to select a provider for the service;*** (Engelhart, Fig. 2 and Page 2, Paragraphs [0024]-[0026], "With reference to FIG. 2, the device 122 communicates to an access node 102 a query Q1 for capabilities and or costs.").
- ***a transmitter capable of sending a request to indicate a value of a selection parameter to the plurality of service providers,*** (Engelhart, Fig. 2 and Page 2, Paragraphs [0024]-[0026], "The access node 102, in turn, communicates to call control nodes 106,108 the queries Q2 and Q3, respectively, for capabilities and costs.").
- ***the receiver capable of receiving response having an indicated value from each of the plurality of service providers;*** (Engelhart, Fig. 3 and Page 2, Paragraphs [0027]-[0030], "The call control node 108 communicates a response R4 to the access node 102. The response R4 comprises the information of response R1 (the costs and capabilities of the service node 114) as well as the costs and capabilities of the call control node 108.").
- ***a selector capable of selecting a provider from the plurality of service providers based on the indicated value from each response.*** (Engelhart, Fig. 2 and Page 3, Paragraph [0033], "With reference to FIG. 5, the device 122 displays the information of response R5 as a list of options 502. The options reflect the capabilities and cost information returned in response to the queries. The options include the type of access available (for example, GPRS or DSL), the quality of service (bits per second, voice only, voice and data), and services available (voice mail, stock quotes, email, web browsing, video), and the cost per minute."... "The device 122 may be configured to automatically select a combination of access, quality, and service based upon the device user's preferences and the costs.").

As per claim 27, the rejection of claim 25 is incorporated and further Engelhart discloses:

- ***at least a portion of the plurality of service providers are re-requested to indicate the value of a selection parameter by the selecting device.*** (Engelhart,

Page 2, Paragraph [0027] and Page 3, Paragraph [0033], "An access node could inform a user device of available price changes." ... "Further, a user device may periodically request updated costs and services information from the network, without requiring subscriber initiation. Rules may be set-up by a subscriber to request or select specific services according to a rule set.").

Claim 30 is the device claim corresponding to the method claims 23-24 and is rejected under the same reasons set forth in connection of the rejection of claims 23-24.

Claim 31 is the device claim corresponding to the method claim 22 and is rejected under the same reason set forth in connection of the rejection of claim 22.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhart (US Patent Publication No. 2004/0203580 A1).

As per claim 14, the rejection of claim 13 is incorporated and further Engelhart discloses:

- ***the mobile station is informed about the selected provider.*** (Engelhart, Page 3, Paragraphs [0033] and [0037]-[0039], "The device 122 may be configured to automatically select a combination of access, quality, and service based upon the device user's preferences and the costs." ... "The device may also display a service provider name for one or more of the potential plural services enumerated on the device

display."), Engelhart teaches that the service provider may be automatically selected and that the name of the service provider may be displayed. Therefore, it would be obvious to one of ordinary skill in the art that the invention taught by Engelhart is capable of informing a mobile device via its display of the automatically selected service provider.

Claims 17-19, 21, 26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhart (US Patent Publication No. 2004/0203580 A1) in view of Allen et al (Allen) (US Patent Publication No. 2003/0182413 A1).

As per claim 17, the rejection of claim 16 is incorporated and further Engelhart discloses:

- ***a provider is selected by a most favorable value from the values received,*** (Engelhart, Fig. 2, Page 2, Paragraphs [0027]-[0030] and Page 3, Paragraph [0033], "In a given embodiment, displayed costs and services may be separately itemized for access, control, or service nodes, allowing for example, a selection of the lowest integrated combination by a subscriber."), Engelhart teaches selecting a provider based on the values received.
- ***at least a portion of the plurality of service providers are re-requested to indicate the value of a selection parameter by the selecting device.*** (Engelhart, Page 2, Paragraph [0027] and Page 3, Paragraph [0033]).

Engelhart does not specifically disclose:

- ***after a first time interval the values received are compared with each other,*** However, Allen in an analogous art discloses the above limitation. (Allen, Page 14, Paragraphs [0282] and [0284]), Allen teaches comparing cost and quality of services being offered by service providers.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Allen into the method of

Engelhart to compare the received values with each other. The modification would be obvious because one of ordinary skill in the art would only want a way to allow a user to compare the performance criteria of different service providers. (Allen, Abstract).

As per claim 18, the rejection of claim 17 is incorporated and further Engelhart discloses:

- ***the portion of the plurality of service providers are re-requested to indicate the value of a selection parameter within a third time interval.*** (Engelhart, Page 2, Paragraph [0027] and Page 3, Paragraph [0033], "Further, a user device may periodically request updated costs and services information from the network, without requiring subscriber initiation."), Engelhart teaches that cost information.

As per claim 19, the rejection of claim 18 is incorporated and further Allen discloses:

- ***the portion of the plurality of service providers are notified of the most favorable value.*** (Allen, Fig. 2, Pages 8-9, Paragraph [0178] and Page 11, Paragraphs [0227]-[0228]), Allen teaches that service providers are informed via a web site of the performance criteria of service providers and are able to discount their rates as a result.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Allen into the method of Engelhart to notify a portion of the service providers of the best value. The modification would be obvious because one of ordinary skill in the art would want to obtain the best price possible for the service being sought. By providing the best price to the service provider, this gives the provider the opportunity to lower their price in order to obtain the user's business (Allen, Page 11, Paragraph [0028]).

As per claim 21, the rejection of claim 18 is incorporated and further Engelhart discloses:

- ***the value from the request is different than the value from the re-request.*** (Engelhart, Page 2, Paragraph [0027] and Page 3, Paragraph [0033], "Rules would be

particularly helpful, for example, in periodic network service requests. Upon finding a better or cheaper network configuration, the user layer device could request subscriber authorization (e.g., on a user device display), or auto-authorize an alternative configuration, based on a subscriber established rule set.”).

Claim 26 is the device claim corresponding to the method claim 17 and is rejected under the same reason set forth in connection of the rejection of claim 17.

Claim 28 is the device claim corresponding to the method claims 17 and 19 and is rejected under the same reasons set forth in connection of the rejections of claims 17 and 19.

Claim 29 is the device claim corresponding to the method claim 21 and is rejected under the same reason set forth in connection of the rejection of claim 21.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhart (US Patent Publication No. 2004/0203580 A1) in view of Allen et al (Allen) (US Patent Publication No. 2003/0182413 A1) and in further view of Campbell et al (Campbell) (US Patent Publication No. 2002/0023033 A1).

As per claim 20, the rejection of claim 19 is incorporated; however, neither Engelhart nor Allen specifically discloses:

- ***the portion of the plurality of service providers are informed if the most favorable value has been indicated by at least two of the plurality of service providers.*** However, Campbell in an analogous art discloses the above limitation. (Campbell, Fig. 9, Pages 9-10, Paragraphs [0102]-[0105] and Fig. 8B, Page 11, Paragraph [0118], “The feedback may also provide some of the terms of one or more proposals, such as the next to best proposal. Such feedback enables the providers to gauge what the current market price level is for the particular item requiring funding.”), Campbell teaches that terms of a plurality of service providers are disclosed to other

service providers. Therefore it would be obvious to one of ordinary skill in the art that since multiple offers are disclosed, if the best value is indicated by more than one service provider then it is provided.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Campbell into the method of Engelhart and Allen to notify a portion of the service providers if the best value is indicated by more than one service provider. The modification would be obvious because one of ordinary skill in the art would want to provide service providers with the ability to gauge prices for a particular service and enable providers to be offer better or equal value in order to be competitive (Campbell, Page 11, Paragraph [0118]).

### **Conclusion**

12. The prior art not relied upon but considered pertinent to applicant's disclosure is made of record and listed on form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANGELA T. CHAMBERS whose telephone number is 571-270-3168. The examiner can normally be reached Monday through Thursday, 8:30am-6pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chameli Das, can be reached at 571-270-1392. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tangela T. Chambers

Patent Examiner

Art Unit 4141

April 16, 2008

/CHAMELI C. DAS/

Supervisory Patent Examiner, Art Unit 4141